

### Remarks

The various parts of the Office Action are discussed below under related headings.

#### ***Claim Rejections - 35 USC § 102***

At the outset, it is noted that a rejection of claims 12-19 under 35 U.S.C. §102(b) is improper. Hunter '485 issued on April 30, 2002, which is over 1 year **after** the March 15, 2001 filing date of the present application. As such, Hunter '485 does not qualify as a patent or printed publication in existence more than one year prior to the filing date of the present application. For purposes of this reply, it is assumed that the Examiner intended to issue a rejection of claims 12-19 under 35 U.S.C. §102(e), and not 35 U.S.C. §102(b).

Claim 12, which was amended for clarification and to correct a typographical error, recites a system for applying an element to a body. The system includes a **device for preparing and/or producing a connection** between the element and the body and a position detection device for detecting a position of the **device for preparing and/or producing a connection** between the element and the body, and for detecting a position of the body.

Hunter '485 fails to disclose or fairly suggest a system for applying an element to a body, which includes a device for preparing and/or producing a connection between the element and the body. In contrast, Hunter '485 is concerned with a method for generating a display representing relative positions of two structures. Hunter '485 simply discloses detecting the relative position of an instrument and a patient. In other words, the claimed invention recites a system for guided production of a connection between an element and a body, while Hunter '485 is no way concerned with preparing or producing such a connection. Further, Hunter '038 and Melkent, taken alone or in combination, fail to cure the deficiencies of Hunter '485.

It is respectfully submitted that claim 12 and claims 13-19 dependent therefrom distinguish patentably over the references of record. Accordingly, the rejection should be withdrawn. In addition, the dependent claims recite additional features of the invention that are not disclosed or suggested in a combination similar to that claimed.

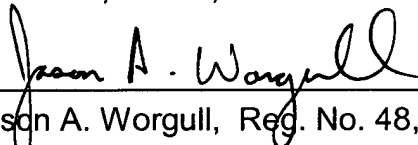
For example, dependent claim 13 recites a number of devices for preparing and/or producing a connection between a body and an element, including at least one of a drill, a saw, a surface-working device, a screwing device, and a nailing device. None of these devices for preparing and/or producing a connection between a body and an element is disclosed or suggested by the cited references, taken alone or in combination.

Newly added independent claim 20 recites additional and unobvious features of the invention. For example, claim 20 recites a system for applying an element to a body, which includes *inter alia* **means for applying the element to the prepared or produced connection**, wherein applying the element to the prepared or produced connection **aligns the element to the body without detecting a position of the element itself**. Hunter '485 fails to disclose or otherwise fairly suggest such a feature. In fact, as discussed above, Hunter '485 is concerned with detecting the relative position of an instrument and a patient. None of the other cited references, taken alone or in combination, cure the deficiencies of Hunter '485. Accordingly, it is submitted that claim 20 distinguishes patentably over the references of record.

The application is now believed to be in condition for allowance and an early action to that effect is earnestly solicited.

Respectfully submitted,

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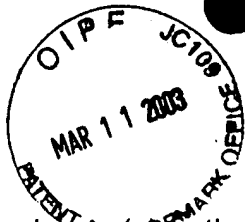
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Date: March 3, 2003

  
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Marcia V. Hill



## APPENDIX

The change(s) to the specification and/or claims are below shown by underscoring and bracketing.

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***In the Claims:***

Please amend claim 12 as follows:

12. (Amended) A system for applying an element to a body, comprising:
- a) a device for preparing and/or producing a connection between said element and said body; and
  - b) a position detection device (i) for detecting [the] a position of said device[,] for preparing and/or producing a connection between said element and said body, and (ii) for detecting [the] a position of said body.

Please add the following new claim.

20. (New) A system for applying an element to a body, comprising:
- a) a device for preparing and/or producing a connection between said element and said body;
  - b) a position detection device for detecting the position of said device for preparing and/or producing a connection between said element and said body, and for detecting the position of said body; and
  - c) means for applying the element to the prepared or produced connection, wherein applying the element to the prepared or produced connection aligns the element to the body without detecting a position of the element itself.